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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,432	03/02/2004	Juergen Benz	588.1016	5411
23280	7590	12/28/2006	EXAMINER	
DAVIDSON, DAVIDSON & KAPPEL, LLC 485 SEVENTH AVENUE, 14TH FLOOR NEW YORK, NY 10018			LE, DAVID D	
		ART UNIT	PAPER NUMBER	
		3681		
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	12/28/2006	PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/791,432	BENZ ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	David D. Le	3681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 October 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 02 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

1. This is the fourth Office action on the merits of Application No. 10/791,432, filed on 02 March 2004. Claims 1-22 are pending.

### **Documents**

2. The following documents have been received and filed as part of the patent application:

- Foreign Priority Document, received on 03/02/04
- Declaration and Power of Attorney, received on 04/23/04
- Information Disclosure Statement, received on 10/17/05
- New Declaration and Power of Attorney, received on 04/07/06

### *Claim Rejections - 35 USC § 112*

**3. The following is a quotation of the first paragraph of 35 U.S.C. 112:**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The present specification does not adequately disclose how the claimed maximum free-wheeling gear and the claimed maximum free-wheeling speed are determined or predetermined. Since the present specification does not appear to adequately disclose how the maximum free-wheeling gear or speed is determined or predetermined, it is unclear how the drivetrain can be placed in the free wheeling mode without knowing the maximum free-wheeling gear or speed.

5. **The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-17, 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

*Claim 1:*

- Lines 3-4 recite the limitation “controlling the clutch so as to change from an engine braking mode to a free wheeling mode”. It is unclear how the clutch is controlled in order to enable a change from an engine braking mode to a free wheeling mode.

*Claim 3:*

- Lines 1-3 recite the limitation “wherein the clutch is disengaged to implement the free-wheeling mode when a transmission gear is equal to or less than a maximum free-wheeling gear”. Since the transmission is known to engage and operate one

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gear ratio at a time, it is unclear what the difference between the currently engaged transmission gear and the maximum free-wheeling gear. Should the currently engaged transmission gear is the same as the maximum free-wheeling gear since there is only one gear engaged at the time?

Claim 4:

- Line 2 recites the limitation “a gas pedal”. It is unclear whether this newly recited “a gas pedal” is different from the one, which is first recited on line 5 of claim 1.

Claim 15:

- Line 2 recites the limitation “a gas pedal”. It is unclear whether this newly recited “a gas pedal” is different from the one, which is first recited on line 5 of claim 1.

Claim 20:

- Lines 4-5 recite the limitation “wherein the clutch is disengaged to implement the free-wheeling mode when a transmission gear is equal to or less than a maximum free-wheeling gear”. Since the transmission is known to engage and operate one gear ratio at a time, it is unclear what the difference between the currently engaged transmission gear and the maximum free-wheeling gear. Should the currently engaged transmission gear is the same as the maximum free-wheeling gear since there is only one gear engaged at the time?

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Claim 21:

- Lines 4-5 recite the limitation “wherein the clutch is disengaged to implement the free-wheeling mode when a driving speed is less than a maximum free-wheeling speed”. It is unclear whether the claim is referring to the speed ratio of the current driving gear when compares to the speed ratio of the maximum free-wheeling gear or the speeds of the vehicle.

***Response to Arguments***

7. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

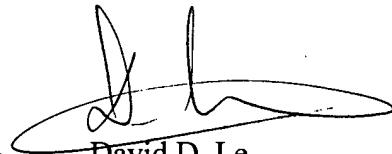
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Le whose telephone number is 571-272-7092. The examiner can normally be reached on Mon-Fri (0700-1530).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



David D. Le  
Examiner  
Art Unit 3681  
12/26/2006

ddl